

Remarks

The non-final Office Action dated June 11, 2009 lists the following new grounds of rejection: claims 1 and 4-8 stand rejected under 35 U.S.C. § 103(a) over AAPA in view of Wolfgang (DE 10001415) and further in view of Hirler (U.S. Patent No. 6,498,382); and claims 9-14 stand rejected under 35 U.S.C. § 103(a) over AAPA in view of Wolfgang and the '382 reference as applied to claims 1 and 5-8 above, and further in view of Baliga (U.S. Patent Pub. 2002/0177277); claim 3 stands rejected under 35 U.S.C. § 103(a) over AAPA in view of Wolfgang and the '382 reference as applied to claim 1 above, and further in view of Tihanyi (U.S. Patent No. 5,973,360). In the discussion set forth below, Applicant does not acquiesce to any rejection or averment in this Office Action unless Applicant expressly indicates otherwise.

Applicant respectfully submits that there is no reference with the publication number DE 10001415 in the record. It appears that the Office Action might be referring to publication number DE 10007415, which was already presented in a rejection that was overcome over a year ago. Applicant requests clarification, but for the purposes of this response assumes that the correct publication number is in fact DE 10007415.

Applicant traverses each rejection and expresses some frustration as it has already been established that the '415 reference cannot be used as prior art without first providing an English translation. According to M.P.E.P. § 706.02, "If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection." In this instance the only copy of the Wolfgang '415 reference in the file wrapper is in a language other than English. This copy was provided by Applicant thereby satisfying the duty of disclosure with respect to the references. Now that the Office Action is relying upon the references as the basis for a rejection, a translation of the references is required. Without such a translation Applicant (and also any examiner who does not understand the non-English language) would be unable to determine the propriety of the rejection. Accordingly, the rejections for each of the claims are improper and Applicant requests that they be withdrawn. Should the rejections be maintained, an English translation must be obtained and

Applicant would request an opportunity to respond before a final office action to develop a clear issue pursuant to M.P.E.P. § 706.07.

While Applicant respectfully declines to engage in a hypothetical discussion about what this misidentified and un-translated reference may or may not teach, Applicant notes that the Office Action's attempted use of *In re Woodruff*, 919 F.2d 1575 (Fed Cir. 1990) is improper. As explained in M.P.E.P. § 2144.05, *in re Woodruff* dealt with a "case where the claimed ranges 'overlap or lie inside ranges disclosed by the prior art'". The Office Action has not established that there is such an overlap, and accordingly, a *prima facie* case has not been established. Without first being presented with a *prima facie* case, Applicant is under no obligation to present evidence of criticality.

Moreover, the record is entirely silent not only about the claimed ranges, but also about any reason to experiment with such ranges. The law is clear that "(a) particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation." M.P.E.P. § 2144.05 citing to *In re Antonie*, 559 F.2d 618 (CCPA 1977). No such result-effective recognition has been established and accordingly, the rejection is improper. Notwithstanding, Applicant's specification provides, with particularity, a number of reasons that the claimed ranges are important (*see, e.g.*, pages 4-5 as further supported by figures 4-10).

Applicant also submits that the Office Action relies upon illogical reasoning to support the rejection. "The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit." M.P.E.P. § 2141. The reasons presented for the combination are aspects relating to "permittivity, reduction of on resistance and reduced length in drift path." Instant Office Action, page 4. No evidence in the record, however, is presented to explain why each of these reasons would be desirable in AAPA. Nor is it explained how these aspects would be realized by the combination. A closer look at the references shows that this alleged reason is illogical. For instance, the '382 patent explains that the permittivity can be lowered by replacing silicon dioxide with a gas-filled

or evacuated cavity. Thus, the alleged advantages are due to replacement of silicon dioxide with a gas-filled or evacuated cavity. As there is no silicon dioxide area in need of such replacement in AAPA, logic dictates that the skilled artisan would not use these teachings of the '382 patent for aspects relating to "permittivity, reduction of on resistance and reduced length in drift path."

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Peter Zawilski, of NXP Corporation at (408) 474-9063 (or the undersigned).

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